



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,803	03/30/2001	Zhongming Yu	49986-0504	7413

29989 7590 08/11/2004

HICKMAN PALERMO TRUONG & BECKER, LLP
1600 WILLOW STREET
SAN JOSE, CA 95125

EXAMINER

NOLAN JR, CHARLES H

ART UNIT	PAPER NUMBER
----------	--------------

2854

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/823,803	YU, ZHONGMING	
	Examiner	Art Unit	
	Charles H Nolan, Jr.	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 19-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebner in view of Daughton et al. (4,475,806).

With respect to Claims 1,3,12, Ebner teaches the selecting steps where the first, second and third paper sources and page ranges are different in column 5, lines 35-42(see also figures 3A and 3C-3D) and the transmitting step in figure 3B. Ebner teaches all the claim limitations except for the determining step. Daughton teaches the determining step (empty medium tray detection) in column 3, lines 7-22. It would have been obvious to one of ordinary skill in the art to incorporate the determining step of Daughton into the invention of Ebner to "indicat[e] to the user that the paper tray needs attention" as taught by Daughton in column 3, lines 18-19. With respect to Claims 2 and 15, Ebner teaches the receiving and generating steps in figures 3B and 3D. With respect to Claims 4,8,13,17, Ebner teaches the receiving and generating steps in figures 3A-3D and his claim 15. With respect to Claim 5, Ebner teaches that different paper sources may be printed with different ink(toner) colors in figure 3C @ 96 or 102 and column 3, lines 20-25. With respect to Claim 6, Ebner teaches the simplex or duplex modes in figure 3A and column 3, lines 23-25. With respect to Claim 7, Ebner

Art Unit: 2854

teaches the receiving and transmitting steps in figure 2. Ebner teaches all the claim limitations except for the displaying step. Daughton teaches the displaying step in column 3, lines 16-19. It would have been obvious to one of ordinary skill in the art to incorporate the displaying step of Daughton into the invention of Ebner to "indicat[e] to the user that the paper tray needs attention" as taught by Daughton in column 3, lines 18-19. With respect to Claims 9-10, Ebner teaches that the set of one or more includes the set of two or more in column 2, lines 1-7 and the receiving and transmitting steps in figures 2 and 3A-3D. With respect to Claim 11, Ebner teaches sending the various paper sources and page ranges in a single print request in his claim 15. With respect to Claim 14, Ebner teaches the second recited receiving step and the second recited transmitting steps in figures 2 and 3A-3D. Ebner teaches all the claim limitations except the first recited transmitting step and the first recited receiving step. Daughton teaches the first recited receiving and transmitting step in column 3, lines 7-22. It would have been obvious to one of ordinary skill in the art to incorporate the first recited receiving and transmitting steps of Daughton into the invention of Ebner to "indicat[e] to the user that the paper tray needs attention" as taught by Daughton in column 3, lines 18-19. With respect to Claims 16 and 18, Ebner teaches the receiving, generating and transmitting steps in figures 2 and 3A-3D. Ebner teaches all the claim limitations except for the recitation of "currently available" in the claim. Daughton teaches the currently available(not empty) recitation in column 3, lines 7-22. it would have been obvious to one of ordinary skill in the art to incorporate the "currently available" function of

Art Unit: 2854


Daughton into the invention of Ebner to "indicat[e] to the user that the paper tray needs attention" as taught by Daughton in column 3, lines 18-19.

3. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 571-272-2171. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles H Nolan, Jr.
Primary Examiner
Art Unit 2854

CHN